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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92048989
Party	Defendant Van Nelle Tabak Nederland BV
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

TOP TOBACCO, L.P.,)	
)	
Petitioner,)	
)	
v.)	Cancellation No. 92048989
)	
VAN NELLE TABAK NEDERLAND, BV,)	
)	
Respondent.)	
)	
)	

RESPONDENT’S RESPONSE TO MOTION TO STRIKE

RESPONDENT’S MOTION TO COMPEL

Respondent Van Nelle Tabak Nederland, BV (“Respondent”) hereby responds to Petitioner Top Tobacco, LP’s Motion to Strike Respondent’s Motion to Compel and for its response states as follows.

I. BACKGROUND

This is a cancellation proceeding in which Top Tobacco, L.P. (“Top Tobacco”) seeks to cancel U.S. Registration Nos. 2,950,896 and 3,328,623 on grounds of abandonment. The Board instituted the proceeding on March 7, 2008. Discovery opened on May 16, 2008. On December 11, 2008, Top Tobacco filed a Motion to Compel Discovery and for Extension of Discovery and Trial Periods. [D.E. 12]. On January 2, 2009, the Board suspended the proceeding pursuant to Trademark Rule 2.120(e)(2), with respect to all matters “not germane” to the pending motion, [D.E. 14], and on January 16, 2009, Respondent filed its Motion to Compel Discovery and for Order Deeming Requests for Admissions Admitted. [D.E. 15].

Top Tobacco's motion to strike Respondent's motion to compel is based on its position that Respondent's motion to compel is in violation of the Board's order because Respondent's motion to compel is "not germane" to Top Tobacco's pending motion to compel.

II. ARGUMENT

Trademark Rule of Practice § 2.120(e)(2) and TBMP §§ 510.03(a), 523.01 describe the Board's standard practice of suspending proceedings with respect to all matters not germane to a filed motion to compel, and directs the parties not to "file any paper which is not germane to the discovery dispute, except as otherwise specified in the Board's suspension order." The Board's Order suspending in this proceeding reflects the wording of this general rule of practice.

As Top Tobacco is well-aware, Top Tobacco and Respondent's sister company have very recently been in the same position before the Board in the still pending *John Player & Sons Limited v. Top Tobacco, LP* (Cancellation No. 92046734). However, in that case, when Respondent's sister company filed a motion to compel while Top Tobacco's motion to compel was pending, Top Tobacco did not file a motion to strike or otherwise object. Nor did the Board consider the filing to be "not germane" to the issues presented by Top Tobacco's pending motion as evidenced by the Board's substantive consideration of both pending motions in a single order [D.E. 26 in Cancellation No. 92046734]. In fact, before filing a cross-motion to compel following suspension in that proceeding, the undersigned counsel sought guidance from the Board on whether a cross-motion to compel would be appropriate in light of suspension and proceeded on that basis. Thus, the Board has permitted (and in fact encouraged), a cross-motion to compel discovery, notwithstanding suspension.¹

¹ Respondent acknowledges that any informal guidance offered by the Board in a separate proceeding would not be binding here.

What is considered “germane” to a pending motion is not addressed in the Trademark Rules of Practice or the TBMP, but it is implicit that the Board may exercise its discretion in making this determination. In *International Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597 (TTAB 2002), the Board considered whether an opposer’s motion to amend the notice of opposition was germane to a previously filed motion for summary judgment, which had triggered a suspension of the proceeding. The Board found that under the facts before it, the motion to amend the notice of opposition *was germane* to the pending dispositive motion and should be permitted. The Board’s reasoning was that the pending motion to amend “related to the issue of whether applicant’s [earlier filed] motion was one for complete or partial summary judgment.” *Id.* at 1603-1604. In other words, the Board found that resolution of one issue could affect the outcome of the other.

The purpose of permitting additional filings that are germane to an issue pending before the Board, even in the face of suspension, is obvious. The Board wishes to resolve related issues together. It would be a waste of resources to decide a motion to compel discovery filed by one litigant, only to have to revisit many of the same facts and legal issues in the context of a second motion to compel discovery, filed by an opposing party immediately thereafter after suspension was lifted.

Though this case concerns abandonment, Top Tobacco seeks information and documents that are not related to the two registrations that are subjects of the current cancellation proceeding and seeks information and documents from prior to the earliest filing date associated with either of these registrations, i.e. February 6, 2003. Respondent has refused to provide this information in discovery on the basis that it is irrelevant to the current proceeding and is not

reasonably likely to lead to the discovery of admissible information pursuant to TBMP § 402.01 and Fed. R. Civ. P. 26(b)(1).

Conversely, Top Tobacco has refused to produce any information or documents that relate to its original basis for filing the cancellation proceeding, has refused to admit or deny that no such information or documents exist, and has refused to answer discovery requests directed to its knowledge of Respondent's use of ROUTE 66. Top Tobacco also has taken the position that documents and information relating to its own asserted plans to use the ROUTE 66 trademark (upon which it relies for standing in the Petition for Cancellation) are not relevant to the issues before the Board, though this same issue was addressed by the Board in the above-mentioned *John Player & Sons Limited v. Top Tobacco, LP* (Cancellation No. 92036734).

The issue before the Board is the proper scope of discovery in a cancellation proceeding involving two issued registrations under a theory of abandonment. This issue is common to both Petitioner's and Respondent's discovery motions currently pending before the Board. Respondent's Motion to Compel Discovery and for Order Deeming Requests for Admissions Admitted is thus directly germane to Petitioner's Motion to Compel Discovery and should not be stricken.

III. CONCLUSION

For the forgoing reasons, Respondent requests that Petitioner's Motion to Strike Respondent's Motion to Compel be denied.

Respectfully submitted,

/Amy S. Cahill/

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Counsel for Respondent
VAN NELLE TABAK NEDERLAND, BV

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Response to Motion to Strike Motion to Compel is being mailed via first class mail, postage prepaid, to counsel for Petitioner, Antony J. McShane, Esquire, Lara Klapper, Esquire and Gregory J. Leighton, Esquire, Neal, Gerber & Eisenberg LLP, Two North LaSalle Street, Chicago, Illinois 60602-3801, on this 16th day of February 2009.

s/ Amy S Cahill
Amy S. Cahill

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